ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted on January 27, 2004. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 14, 16, 20-27, and 32-59 remain in this application. Claims 1-13, 15, 17-19 and 28-31 have been canceled. Applicant notes that the amendments provided in this response are for clarification purposes only, and do not raise new issues. Accordingly, applicant requests that the Examiner enter the amendments to put the application in a condition for appeal.

Claims 14, 16, 20-27, and 32-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Anderson *et al.* (U.S. 5,721,783) in view of Single (WO 97/01314). For the following reasons, the rejection is respectfully traversed.

Claim 14 recites a step of "applying to said an output converter at least one second electrical signal representing at least one second audio signal of predetermined duration for notifying the user of a status of said hearing device" and a step of "selecting the content of said second audio signal by said individual". Thus, the status notification signal content is user-selectable.

At the personal interview, the Examiner and applicant discussed the issue of the user being able to select an audio signal that is used by the device to notify of the user of a status of the device. Applicant's representative argued that this feature was not shown in the prior art. The Examiner argued that the references teach that a user can store messages, and that it would be obvious to use such stored messages as status notifications. Accordingly, the Examiner refused to reconsider the rejections.

Even if true, it is not relevant if the prior art teaches the ability to store messages. None of the references suggest a device whereby a user can select a status notification message. Teaching user-recordable messages does not suggest

that those messages can be triggered by a device *status* event.

For example, at most, Anderson suggests a "verbal warning" that a "battery is low" (see col. 2, lines 40-42) and a "verbal message" to "inform the user that system capabilities have been restored" (col. 21, lines 63-65). There is no suggestion that the user can change any of these status audio signals. The Examiner has failed to show exactly where Anderson teaches a user-selectable status message.

Further, nowhere does Single suggest any such capability. The Examiner cites col. 15, line 25- col. 16, line 10 as teaching this feature. However, a close reading of this passage does not support the Examiner's assertion. Instead, the cited passages merely teach that a user can request internal status reports by depressing certain keys. There is no suggestion that a user can select the message played during the status notification. Instead, Single implies that these messages are pre-set, and there is no suggestion that they can be user selected.

First, neither reference suggest that a status notification be user selectable, thus there can be no such feature in a combination of the references. The prior art references must teach or suggest *all* of the claim elements and/or claim limitations (MPEP §2143.03). The Examiner has provided no support for user-selectable status notifications. Accordingly, even if combined, the references do not suggest the user selectable status message of claim 14. Thus, claim 14 is patentable over the references, even if combined.

Second, the Examiner stated at the personal interview that it would be "obvious" to use the user-recorded memo taught by Anderson for the status notification of Single. However, the Examiner has failed to provide anything other than hindsight motivation for making such a modification.

The Examiner has not provided any legally sufficient motivation for modifying the references to obtain the invention. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness

(*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*).

Merely listing an *advantage* of the combination is also not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention '*as a whole*' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not piecemeal.

Accordingly, claim 14 is patentable over the references for this reason as well.

Claims 16 and 20-25, which depend on claim 14, either directly or indirectly, are thus patentable over the references for the same reasons (as well as for the limitations contained therein).

Claim 26, as amended, recites a "generator unit including a *user exchangeable storage* with at least one audio signal, the content thereof being user selectable for signifying a status of the system". Claim 27 recites storing "user selectable signals according to user defined audio signal sequences of predetermined extent to be output by said generator unit for notifying a user of a status of the system". As discussed above for claim 14, the references do not suggest that any "status" audio signal content is "user selectable". Accordingly, claims 26 and 27 are patentable over the references for the same reasons as claim 14.

Further none of the references suggest storing any *status messages* in "user exchangeable storage" as recited in claim 26, and thus claim 26 is patentable over the references for that reason as well.

Claims 32-35, which depend on claim 27 either directly or indirectly, are thus patentable over the references for the same reasons as claim 27 (as well as for the limitations contained therein).

Claim 36 recites "initiating an acknowledgement audio signal" wherein "said acknowledgement audio signal is made selectable by the individual". As discussed for claim 14, above, the cited references do not suggest user selectable audio signals for status indications nor, for this claim, for acknowledgement audio signals. Hence, new claim 36 is patentable over the references.

Claims 37-49, which depend, directly or indirectly, on claim 36, are patentable for the same reasons (as well as for the limitations recited therein).

Claim 50 recites similar "user selectable" stored signals at lines 9-10, and thus claim 50 is patentable over the references for the same reasons discussed above. Claims 51-59, which depend, directly or indirectly, on claim 50, are patentable for the same reasons (as well as for the limitations contained therein).

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.